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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,378	11/02/2001	Guido Baumocler	H-3954-PCT/U	9714
23657	7590	12/23/2005	EXAMINER	
COGNIS CORPORATION PATENT DEPARTMENT 300 BROOKSIDE AVENUE AMBLER, PA 19002			FORTUNA, JOSE A	
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/913,378

Applicant(s)

BAUMOELLER ET AL.

Examiner

José A. Fortuna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/31/05</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Note that the claims are drawn to a method of making paper substrate.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 10-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Haut et al (6,207,014).

de Haut et al. disclose the impregnation of paper with an aqueous softening lotion. The lotion contains the following components (last paragraph of column 5):

- a) 35-95% fatty alcohol
- b) 1-50% waxy esters having a total of 24-48 carbon atoms
- c) Up to 20% nonionic/amphoteric emulsifiers
- d) Up to 50% mineral oil or wax.

The waxy esters are listed in column 2, lines 27-32 and include the ones recited in present claim 13. The preferred amount of emulsifier is 1.5 -5%, wax is 1-10% see column 8, lines 50-65.

One of the preferred non-ionic polyol emulsifier is in particular polyglycerol poly-12-hydroxystearate, column 7, lines 60-62.

The claims by virtue of the "comprising" and "containing" language is open to the presence of the fatty alcohol of de Haut et al's composition. Thus, at the very least, it would have been obvious to select those components and amounts, which de Haut et al considered to be preferred over other listed components. Therefore one of ordinary skill in the art would have selected the preferred amount of wax and the polyglycerol poly-12-hydroxystearate the non-ionic emulsifier.

***Response to Arguments***

Applicants' arguments are premised on de Haut et al's broad disclosure of such a multiplicity or multitude of choices for each of the components of the lotion that de Haut et al cannot anticipate the claimed invention. It is further argued there is also no guide as to the selection of one member of a component over others. The fact is that the selection is based on members of component that de Haut et al considered preferred over others and does require undue experimentation or speculation as implied by Applicants arguments.

Also applicants state that there are unexpected results in the use of the claimed emulsion and presented a declaration under 37 C.F.R. §1.132 to show said alleged unexpected results. However, the declaration is not commensurable in scope with the claimed subject matter. The reasons being:

a) The affidavit and the specification show the use of the different components of the emulsion within certain levels, i.e., 8-10%<sup>1</sup> for the derivatized Glycerol, between 55-65% for the ester and from 5-7% of the wax<sup>2</sup>. However, the claims do not include any specific range(s) and therefore, read on a range covering almost all possible combinations/permutations of the ingredients. The claims include ranges that are or could be outside of the unexpected range and/or include ranges in which the emulsion won't work as desired and/or would be within the levels of the cited reference. For example as claimed the of the derivatized glycerol could be added to the emulsion at levels that would not considerably affect the emulsion of the cited reference, e.g., at levels 0.01

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<sup>1</sup> No indication is shown as to the units of the numbers indicated on each column/row, i.e., percentage or weight, (grams, pounds, etc.) or just a ratio, it has been assumed to be weight percentage.

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to 1%, just to include a plasticizer in the mixture/emulsion and still would read on the claims as claimed and said emulsion containing said levels of the derivatized glycerol, most likely would not show any unexpected results.

b) Applicants have not explained why the results achieved in the specification would have been unexpected by one of ordinary skill in the art. This is especially significant in this case where the cited reference discloses the preparation of similar paper softening compositions.

Evidence as to unexpected results must be “clear and convincing”, and be of scope reasonably commensurable with the scope of the subject matter claimed. *In re Lohr*, 137 USPQ 548 (CCPA 1963) and *in re Linder*, 173 USPQ 356 (CCPA 1972).

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of “Process of making a Soft Paper.”

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

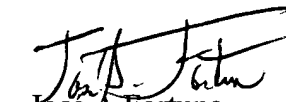
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<sup>2</sup> Composition number 4 has not been considered, since it does not contain the elements of the claims, i.e., it has two waxes, instead of a wax ester and a wax, along with derivatized glycerol. Therefore the 65% of composition 4 has not been considered as part of the claimed invention.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



— José A Fortuna  
Primary Examiner  
Art Unit 1731

JAF